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Docket No. 54821.P1/ C-3520.0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kosaraju Krishna MOHAN, et al.

Serial No.: 09/770,340

Filed: January 26, 2001

For: LOW DENSITY PAPER AND PAPERBOARD ARTICLES

Examiner: Michael C. Miggins (703) 305-0915

Group Art Unit: 1772

RESPONSE TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated September 27, 2002, Applicant submits the following remarks.

In the Office Action, the Examiner issued a requirement that Applicant make an election between the Group I claims (Claims 1 - 19), the Group II claims (Claims 20 - 21) and the Group III claims (Claims 22 - 40). Applicant hereby elects Group III but this election is made with traverse and is solely for the purpose of advancing prosecution of this case. It is believed that the requirement to restrict the invention is improper. The claims are sufficiently related that their respective classes would be thoroughly cross-referenced, and many of the same classes would be searched regardless of which group of claims was elected.

The Group I claims are directed to a paperboard material having expanded microspheres. The Group II claims are directed to a paper container assembled from this paperboard. The Group III claims are directed to a method of making the paperboard material. Hence all three sets of claims require that a search for paperboards structures incorporating expanded microspheres be made.

An examination of any one of the groups of claims will require a search of

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substantially the same prior art as an examination of the remaining two claims. Each would require searching all of the art relating to the construction of paperboard materials including expanded or expandable microspheres. Furthermore, separate examination of the various groups of claims may lead to inconsistent examinations and will likely result in duplication of effort. It is therefore a more efficient use of Patent Office manpower and resources to examine all claims which are closely related at one time rather than conducting separate examinations.

The mere fact that one alleged set of claims is directed to a method and the other alleged sets are directed to products made using the method does not mean a patent cannot be issued containing all sets of claims. Patents are routinely issued containing method and product claims.

Moreover, restriction is not "required" by 35 U.S.C. §121 as suggested by the Examiner. Congress wisely gave the Commissioner the "discretion" to require restriction. According to 35 U.S.C. § 121 "... the Commissioner may require the application to be restricted...." (emphasis added). Likewise, the MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The invention must be independent or distinct; and
- 2) There must be a serious burden on the Examiner if restriction is not required (emphasis added).

Because the Examiner has not shown any serious burden if examination of all the claims is conducted and the claims cover closely related subject matter, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement, that he examine Claims 1 - 40 on their merits, and that he find all claims to define patentable subject matter and issue a Notice of Allowance at his first opportunity.

Respectfully submitted,

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Date: 10/28/02